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Adams and Reese LLP 1221 McKinney Street, Suite 4400 Houston, TX 77010			LUONG, VINH	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,634	Applicant(s) VILLA ET AL.
	Examiner Vinh T. Luong	Art Unit 3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 July 2010 and 18 March 2010.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 July 2010 and 05 August 2004 is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: Appendix

Art Unit: 3656

1. The amendments filed on July 14, 2010 and March 18, 2010 have been entered.
2. The drawings were received on July 14, 2010. These drawings are not accepted by the Examiner because the amendments to the drawings are not in compliance with 37 CFR 1.121.

For example:

(a) 37 CFR 1.121(f) states: "No amendment may introduce new matter into the disclosure of an application." In the instant case:

(i) New FIG. 2B introduces new matter. As noted, the original application did not disclose, *e.g.*, the size, shape, location, and/or the number of the latches (Spec. 6:15-22). The showing of a specific size, shape, location, and number of three latches 73 in new FIG. 2B within a full spectrum of possible sizes, shapes, locations, and numbers of the latches is considered under the present disclosure to be new matter. *Cf., In re Smith*, 173 U.S.P.Q. 679 (CCPA 1972) and *Ex parte George*, 230 U.S.P.Q. 575, 578 (Bd. Pat. App. & Inter. 1986). Put differently, the concept such as the latch actuator 72 comprising three circular spaced apart latches 73 as now shown in FIG. 2B was not conveyed in the original disclosure, *i.e.*, new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973); MPEP §§ 608.04(a) and 2163.06; *Twin Disc v. United States*, 231 USPQ 417, 436 (US Cl. Ct. 1986); 37 CFR 1.81(d) and 35 USC 113; and

(ii) The new showing of the self-lubricating bearing or half-bearing ring assembly 15 in amended FIGS. 4 and 5. The original application did not disclose that the bearing is formed as a circular ring one-piece formed with the support portion 23 (Spec. 8:18-29). To the contrary, the original application implies that the bearing can be formed, *e.g.*, as two separate pieces ("bearing halves") and attached to the support portion 23. Please see different types of bearings in Class 384 of the Office. The showing of a specific circular ring bearing 15, formed as one-

piece with the support portion 23 in amended FIGS. 4 and 5 within a full spectrum of possible bearings is considered under the present disclosure to be new matter;

(b) The drawings are inconsistent with the specification or *vice versa*. Please see 37 CFR 1.121(e). For example, the amended specification on March 18, 2010 describes:

“Fig. 2b: The underside latching elements of the transverse shaft depicted in Fig. 2a is show in a *cross-sectional view*.” (Emphasis added)

However, FIG. 2b is not “a cross-sectional view” as evidenced by the fact that FIG. 2b does not have the hatchings to show all of the materials as they are shown in the view from which the cross section was taken as required under 37 CFR 1.84(h)(3); and

(c) The drawings are inconsistent with the claims or *vice versa*. For example, claim 1 recites “a support of a *plastic* material” and claim 3 recites “the ratchet insert comprises mounting holes, which are filled with *plastic* material.” However, the sectional view in FIG. 5 shows that the support 20 is made of metal and the mounting holes 31 are filled with metal material as seen by the drawing symbols for draftsperson in MPEP § 608.02. Please see 37 CFR 1.84(h)(3) and 1.121(e).

3. The *original* drawings are objected to because of the reasons set forth on pages 2 and 3 of the Office action on September 18, 2009.

4. The *original* drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the *plastic* support 20 in claim 1 (FIG. 5); the mounting holes 31 filed with *plastic* in claim 3 (FIG. 5); the latching elements of the shaft 70 in claim 6; and the bearing bushings or bearing

halves in claim 10 must be shown or the features canceled from the claims. *No new matter should be entered.*

5. The amendment filed March 18, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is, *inter alia*, as follows:

- (a) The description in the paragraph beginning at line 25 on p. 4 of the specification:

“Fig. 2b: The underside latching elements of the transverse shaft depicted in Fig. 2a is show in a *cross-sectional view*.” (Emphasis added)

As noted above, the original application did not disclose, *e.g.*, the size, shape, location, and/or the number of the latches (Spec. 6:15-22). The new description and showing of the specific size, shape, location, and number of three latches 73 in new FIG. 2B within a full spectrum of possible sizes, shapes, locations, and numbers of the latches are considered under the present disclosure to be new matter. *In re Smith, supra*. Similarly, the new description “73 Shaft head and underside latches” inserted below reference sign 60 on p. 10 of the specification introduces new matter; and

- (b) The new description “15 Self-lubricating plastic bearing assembly” added below reference sign 14 on p. 10 of the specification.

The original application did not disclose that the bearing is formed as a circular ring one-piece formed with the support portion 23 as now shown in amended FIGS. 4 and 5 (Spec. 8:18-29). To the contrary, the original application implies that the bearing can be formed, *e.g.*, as two separate pieces (“bearing halves”) and attached to the support portion 23. The new description

Art Unit: 3656

referring to the showing of the specific circular ring bearing 15, formed as one-piece with the support portion 23 in amended FIGS. 4 and 5 within a full spectrum of possible bearings is considered under the present disclosure to be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. The disclosure is objected to because of the informalities, e.g., the descriptions in the specification are inconsistent with each other. Please see 37 CFR 1.121(e). For example, p. 8 of the specification describes:

To the opposite it is also possible to provide such bearings or beating halves at the parking brake lever unit 1. Then, preferably these bearings or bearing halves (*not shown*) comprise of the explained self-lubricating plastic material or a metal. (Emphasis added)

However, the amended p. 10 of the specification describes the self-lubricating plastic bearing assembly 15.

Appropriate correction is required.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 6 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain(s) subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention.

Applicant claims, *inter alia*, the latching elements of the shaft 70 in claim 6, and the bearing bushings or bearing halves in claim 10. However, Applicant's *original* specification did

Art Unit: 3656

not adequately describe and the *original* drawings did not show as to how the latching elements and the bearing bushings or bearing halves are formed or structurally interconnected with other elements as claimed.

9. Claims 1-3, 5, 6, and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer (EP 1127760 A2) in view of Burgstaler (US 2003/0140726 A1).

Claim 1

Bauer teaches a parking brake lever unit for the use in a motor vehicle comprising:
a parking brake lever 8 of a plastic material (*id.*, abstract);
a support 3, 7 at which the parking brake lever 8 is pivotably supported;
a locking unit comprising a pawl 5 mounted at the parking brake lever 8, and a ratchet insert 6.

In summary, Bauer teaches the invention substantially as claimed except the plastic material for the support 3, 7 and the over-molded metal for the ratchet insert 6.

Burgstaler teaches the plastic for making the support 1-3 and the over-molded metal for making the insert 8-11 in order to, *inter alia*, reduce the weight of the parking brake lever unit. Burgstaler, abstract; ¶¶ 5 and 21-25.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use plastic for making Bauer's support and over-molded metal for making Bauer's ratchet insert in order to reduce the weight of Bauer's parking brake lever unit as taught or suggested by Burgstaler.

The modification of Bauer's parking brake lever unit by selecting the materials as taught or suggested by Burgstaler would not have been uniquely challenging to a person of ordinary

skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739. As noted, the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); MPEP 2144.07; and *Ritchie v. Vast Resources Inc. d/b/a Topco Sales*, 90 USPQ2d 1668 (Fed. Cir. 2009). In addition, the determination of patentability is based on the product itself, not by its method of production (over-molding). *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985); *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006); and MPEP § 2113.

Claim 2

Bauer's ratchet insert 6 comprises locking teeth (unnumbered in FIG. 1) and wherein the ratchet insert 6 is integrated into the support 3, 7 so that substantially only the locking teeth are exposed.

Claim 3

Bauer's ratchet insert 6 comprises mounting holes (see Appendix hereinafter "App."), which are capable of being filled with plastic material during injection molding of the support 3, 7. In addition, the determination of patentability is based on the product itself, not by its method of production (injection molding). *In re Thorpe*; *SmithKline Beecham Corp. v. Apotex Corp.*; and MPEP § 2113 *supra*.

Claim 5

Bauer's parking brake lever 8 is pivotally supported by means of a shaft 15 within the support 3, 7.

Burgstaler teaches the parking brake lever 6 being pivotally supported by means of a shaft 31 within the support 1-3, wherein the shaft 31 comprises a plastic material in order to reduce the weight of the unit. Burgstaler, ¶ 25.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Bauer's shaft of plastic material in order to reduce the weight of the Bauer's unit as taught or suggested by Burgstaler.

Claim 6

Bauer's shaft 15 is a self-locking shaft, which comprises integrated latching elements 14, 16, 16a (FIG. 2), so that the shaft 15 is capable of being mounted within the support 3, 7 without additional mounting elements.

Claim 8

Burgstaler teaches the polyamide plastic material, *i.e.*, Applicant's material. In addition, Burgstaler used an additive TPE. Burgstaler, ¶ 30. Thus, Burgstaler's plastic material inherently comprises self lubricating characteristics.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the plastic having self-lubricating characteristics for making Bauer's lever, support, and shaft in order to reduce the weight of Bauer's parking brake lever as taught or suggested by Burgstaler. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR*.

Claim 9

Burgstaler's plastic material comprises additives, such as, TPE for achieving self-lubricating characteristics. Burgstaler, ¶ 30.

Claim 10

Bauer teaches the bearing bushing or bearing halves 14 (FIG. 1).

Burgstaler teaches the bearing bushing or bearing halves 31 of a metal or plastic material. Burgstaler, ¶ 25. In addition, Burgstaler teaches the plastic material comprising self-lubricating characteristics. Burgstaler, ¶ 30.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the plastic having self-lubricating characteristics for making the bearing bushing or bearing halves in order to reduce the weight of the parking brake lever unit of Bauer as taught or suggested by Burgstaler. *KSR*.

Claim 11

Burgstaler's support 1-3 comprises a stiff plate 27, which is ribbed at its underside (FIGS. 2 and 3).

Claim 12

Burgstaler's support 1-3 comprises an essentially plane plate 3 (FIG. 1). Similarly, Bauer's support 3, 7 comprises an essentially plane plate (App.).

Claim 13

Burgstaler teaches metallic mounting inserts 8-11 in order to improve the deformation in case of an accident. Burgstaler, abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the metallic mounting inserts in the plane plate of the support of the

Art Unit: 3656

unit of Bauer and Burgstaler in order to improve the deformation in case of an accident as taught or suggested by Burgstaler. *KSR, supra.*

Claim 14

Bauer's support 3, 7 comprises an integrated latching element (App.) for the mounting of the parking brake lever unit at the vehicle. Similarly, Burgstaler's support 1-3 comprises an integrated latching element 3 (FIG. 4) for the mounting of the parking brake lever unit at the vehicle.

Claim 15

Burgstaler teaches an electrical switch, which can be actuated by the parking brake lever in order to detect the position of the pedal. Burgstaler, ¶ 14.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the electrical switch in the support of the unit of Bauer in order to detect the position of the pedal as taught or suggested by Burgstaler. *KSR.*

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer in view of Burgstaler as applied to claim 1 above, and further in view of Noel et al. (JP 7-190109 A).

Claim 4

Bauer and Burgstaler teach the invention substantially as claimed except the metal or plastic pawl.

Noel teaches the plastic pawl 17 in order to reduce noise. Noel, English abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select plastic for making Bauer's pawl in the lever unit of Bauer as

Art Unit: 3656

modified by Burgstaler in order to reduce noise as taught or suggested by Noel. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR*.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer in view of Burgstaler as applied to claim 1 above, and further in view of Ruf et al. (EP 0933270 A1 cited by Applicant).

Bauer's parking brake lever 8 comprises a grip 11 at its grip area.

Bauer and Burgstaler teach the invention substantially as claimed except the plastic material for the grip.

Ruf teaches the plastic material for the grip 2 in order to reduce weight. Ruf, abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select plastic for making Bauer's grip in order to reduce the weight of the parking brake lever unit of Bauer and Burgstaler'726 as taught or suggested by Ruf. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR*, *supra*.

12. Claims 8-10 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer in view of Burgstaler as applied to claim 1 above, and further in view of Yokochi et al. (US 7,051,616).

Assuming *arguendo* that Burgstaler's plastic material does not inherently comprise self-lubricating characteristics, the following rejection takes place.

Claim 8

Bauer and Burgstaler teach the invention substantially as claimed except the technical plastic material which comprises self-lubricating characteristics for making the Bauer's lever, support, and shaft.

Yokochi teaches the technical plastic material comprising self-lubricating characteristics.

Yokochi, c. 4, l. 62 *et seq.*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a technical plastic which comprises self-lubricating characteristics for making Bauer's lever, support, and shaft in order to reduce the weight of Bauer's parking brake lever as modified by Burgstaler so that no additional lubricants or special bearings or bearing halves must be used as taught or suggested by Yokochi. *Sinclair & Carroll Co. v. Interchemical Corp and KSR, supra.*

Claim 9

Yokochi's plastic material comprises additives, such as, PTFE for achieving self-lubricating characteristics. Yokochi, c. 4, l. 62 *et seq.*

Claim 10

Burgstaler teaches the bearing bushing or bearing halves 31 of a metal or plastic material. Burgstaler, ¶ 25.

In summary, Bauer and Burgstaler teach the invention as claimed except the self-lubricating characteristics.

Yokochi teaches the technical plastic material comprising self-lubricating characteristics. Yokochi, c. 4, l. 62 *et seq.*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the plastic that comprises self-lubricating characteristics for making the bearing bushing or bearing halves in order to reduce the weight of the parking brake lever

unit of Bauer and Burgstaler'726 as taught or suggested by Yokochi. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR, supra*.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 7,059,213 and WP 02/060,731 corresponding to US 2003/0140726 (Burgstaler et al.), Burgstaler'452 (plastic in claim 15), and Burgstaler'335 (plastic in ¶ 7).

14. Applicant's arguments filed on July 14, 2010 and March 18, 2010 have been fully considered but they are not persuasive.

At the outset, on p. 9 of the Amendment filed on March 18, 2010 (hereinafter "Amend."), Applicant contended that US 20030140726) was published after the present application's priority date of April 3, 2003, thus, it would not be qualified to reject Applicant's claims.

The Examiner respectfully submits that Applicant cannot rely upon the foreign priority papers of this application to overcome the rejection based on US 20030140726 because a certified translation of Applicant's priority papers has not been made of record in accordance with 37 CFR 1.55, i.e., Applicant has not perfected the priority claimed in this application. Please see MPEP § 201.15. On the other hand, US 20030140726 were matured to be US 7,059,213. The Pat.'213, in turn, claimed the priority of PCT Pub. No. WO 02/060731 published on August 8, 2002. Hence, even if Applicant has perfected the priority date of April 3, 2003, Applicant's priority date was still *after* the publication date August 8, 2002 of WO'731.

In view of the foregoing, the rejection based on US 20030140726 is reiterated.

Claim 1

Applicant asserted that Bugstaler teaches to not use a plastic material alone for the support of the pedal since the support of the pedal is actually achieved by two side walls formed of a sheet metal within the plastic pedal block. (Amend. p. 10)

In obviousness determinations, all of the features of the secondary reference need not be bodily incorporated into the primary reference. *In re Keller*, 642 F.2d 413,425 (CCPA 1981). As noted, the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881,889 (Fed. Cir. 1984). Further, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

In the instant case, Burgstaler teaches: (a) the plastic material for the support 1-3 of the pedal; (b) the metal insert 8-11; and (c) the process of over-molding of the plastic that forms the support 1-3 over the metal insert 8-11. See Burgstaler's FIG. 5, abstract and ¶¶ 5 and 21-25. In addition, Bauer teaches the support 3, 7 and the ratchet 6. Hence, when one having ordinary skill in the art applies the process of molding of a plastic material over a metal material of Burgstaler in order to form the support and ratchet of Bauer, one would form Bauer's support by the plastic molding and Bauer's ratchet by molding this plastic over Bauer's ratchet. The overmolding of Bauer's ratchet insert flow logically from Burgstaler's teaching of the molding of the plastic over the metal. Simply put, the claimed device in claim 1 is not patentable because it is merely *an application of a known technique*, i.e., the molding of plastic over metal taught by Burgstaler to a piece of prior art of Bauer that is ready for improvement. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739.

Moreover, it is noted that the thrust of Applicant's arguments regarding claim 1 and other claims below is mainly relied on the process of overmolding. However, this application does not claim the process of making of the parking brake lever. Instead, the claims are drawn to the product-by-process. The Examiner is mindful that the determination of patentability is based on the product itself, not by its method of production. *In re Thorpe; SmithKline Beecham Corp. v. Apotex Corp.*; and MPEP § 2113 *supra*. Hence, Applicant's arguments about the overmolding are not accorded patentable weight.

Claim 2

Applicant contended that, in Bauer, the complete ratchet insert 6 is exposed as can be seen in FIG. 1. (Amend. p. 10)

Claim 2 recites: "the ratchet insert is *integrated* into the support so that *substantially* only the locking teeth are exposed." (Emphasis added)

The term "integral" or "integrated" is sufficiently broad to embrace constructions united by such means as fastening and welding. See *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973) and *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997). Integral or "integrated" is not necessarily restricted to one-piece article. *In re Kohno*, 157 USPQ 275 (CCPA 1968). Moreover, the term "substantially" is a relative term, *i.e.*, it is a broad term. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960) cited in MPEP 2173.05(b).

Applying the above principle of law to the facts of this case, Bauer's ratchet 6 is "integrated" into the support 3, 7 by the fastener at the mounting hole as seen in FIG. 1. Further, "substantially" only the locking teeth of Bauer's insert 6 are exposed because the relative term "substantially" in claim 2 does not absolutely or totally require only the teeth to be exposed.

Claim 3

Applicant asserted that “if the ratchet insert is not overmolded, these holes cannot be filled with plastic material during injection molding as is described and claimed in the instant application.” (Amend. p. 10)

As noted, Burgstaler teaches the metal ratchet insert of Bauer to be overmolded by plastic, thus, common sense teaches that the empty space of the mounting holes of Bauer are filled with plastic during such process taught by Burgstaler. See *Perfect Web Technologies Inc. v. InfoUSA Inc.*, 92 USPQ2d 1849 (Fed. Cir. 2009); *Wyers v. Master Lock Co.*, 95 USPQ2d 1525 (Fed. Cir. 2010).

Claim 5

Applicant contended that neither Burgstaler nor Bauer show the plastic shaft as claimed.

During patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. *In re Paulsen*, 30 F.3d 1475, 14F80, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989); *Phillips v. AWH Corp.*, 415 F.3d 1303 [75 USPQ2d 1321] (Fed. Cir. 2005) (*en banc*); and MPEP § 2111. More importantly, words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the applicant. Where an applicant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with

Art Unit: 3656

"reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001); *Merck & Co. v. Teva Pharmaceuticals USA Inc.*, 73 USPQ2d 1641 (Fed. Cir. 2005); *Phillips v. AWH Corp.*, and MPEP § 2111, *supra*.

In the instant case, Applicant does not set out the special definition for the term "a shaft."

On the one hand, ¶ 25 of Burgstaler describes:

The mount for a pivot axis 5, 7 of the pedal 4, 6, which mount is made of two side walls 8, 9 and 10, 11 located opposite each other, consists of sheet metal and is injection molded in the pedal block 1, 2, forms a hole each, which is coated with plastic during the manufacture of the holding device and acts as a bearing element 31 after the completion of the holding device. This means that *the bearing element 31, which is a bearing bush here, as is apparent from FIG. 1, is formed directly during the manufacture of the holding device in an injection molding operation*. The webs 32 are the connection to the plastic pedal block 1, 2. (Emphasis added).

As seen from the quotation above, Burgstaler teaches the injection molding in order to make the plastic bearing bush 31. On the other hand, *Merriam-Webster's Collegiate Dictionary*, 10th Ed., 1999, defines the shaft as "a commonly cylindrical bar used to support rotating pieces or to transmit power or motion by rotation." Here, Burgstaler's FIG. 1 shows that the bearing bush 31 has a cylindrical shape and is used to support the rotating pieces/pivot axes 5, 7. Therefore, Burgstaler's bearing bush 31 "reads on" the claimed shaft based on its ordinary and customary meaning in dictionary.

Assuming *arguendo* that Burgstaler does not teach the plastic shaft, but Burgstaler still teaches the well known plastic material for making the support, *i.e.*, a part of the parking brake

lever unit in order to reduce its weight and Bauer teaches the shaft 15. Hence, it would have been obvious to one having ordinary skill in the art to select the well known plastic material in order to form Bauer's shaft in order to reduce the weight of Bauer's parking brake lever unit as taught or suggested by Burgstaler. *KSR; Sinclair & Carroll Co. v. Interchemical Corp.; In re Leshin*; MPEP 2144.07; and *Ritchie v. Vast Resources Inc. d/b/a Topco Sales, supra*.

Claim 6

In the same vein of arguments, Applicant asserted that Bauer's shaft 15 is not defined in terms of material and is not a self-locking shaft comprising any integrated latching elements. (Amend. p. 11)

As noted above, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. Thus, even if Bauer does not define the shaft 15 in terms of its material, however, Burgstaler teaches the well known plastic material. Hence, it would have been obvious to one having ordinary skill in the art to select the plastic material in order to form Bauer's shaft in order to reduce the weight of Bauer's lever as taught or suggested by Burgstaler. *KSR; Interchemical Corp.; In re Leshin*; MPEP 2144.07; and *Ritchie v. Vast Resources Inc. d/b/a Topco Sales, supra*.

With respect to the integrated latching elements, Applicant's original application did not adequately describe the latching elements. In fact, the original drawings did not show the latching elements. Notwithstanding this fact, as seen in Bauer's FIG. 1, the element 15 is a cylindrical bar used to support rotating pieces 14, 12, etc. Thus, Bauer's element 15 is "a shaft" based on its ordinary and customary meaning as evidenced by the cited *Merriam-Webster* dictionary. Bauer's shaft 15 "reads on" the claimed self-locking shaft since it is locked or fixed

in the support 7 as shown in Bauer's FIG. 1 in the same manner as Applicant's shaft 70 shown in Applicant's original FIG. 1.

Claim 7

Applicant contended that Bauer teaches a grip, Ruf teaches the plastic material for the grip, and Burgstaler teaches the overmolding but not the grip. Nevertheless, Applicant asserted that none of the art of record alone or in combination teaches an over-molded grip attached onto the parking brake lever as claimed. (Amend. p. 11)

As noted above, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. Thus, when one applies the overmolding process of Burgstaler to form the grip of Bauer by plastic as taught by Ruf, one would have the combination as claimed. *KSR, supra*.

Claims 8-10

Applicant contended that Burgstaler teaches only plastic material polyamid for making the lever and tetrapolyethylene (TPE) as a material for the seal. Applicant further asserted that "TPE is a well-known rubber-like elastomer that has *no self-lubricating characteristics at all.*" (Emphasis added) (Amend. p. 11)

It is well settled that an expert's opinion on the ultimate legal issue must be supported by something more than a conclusory statement. *In re Buchner*, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). In the instant case, if the TPE is well known rubber-like that has *no self-lubricating characteristics at all*, Applicant should have supported such conclusion by at least anecdotal evidence, such as, publications, references, etc.

In the absence of Applicant's supporting evidence in the record, the Examiner respectfully submits that claims 8-10 claim the plastic material without the specific composition of the self-lubricating additive material. Burgstaler teaches the plastic material, *i.e.*, the claimed material. Thus, Burgstaler's plastic material is inherently or capable of having self-lubricating characteristics similarly to Applicant's plastic. Please see *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); and MPEP §§ 2112-2112.02.

Applicant further admitted that Yokochi *et al.* teaches PTFE comprising the lubricating material but contended that Yokochi appears to be not eligible for citation because it was filed in the US after this application's priority date.

The Examiner respectfully submits that Applicant cannot rely upon the foreign priority papers of this application to overcome the rejection based on Yokochi because a certified translation of Applicant's priority papers has not been made of record in accordance with 37 CFR 1.55. Please see MPEP § 201.15 *supra*.

Claim 14

Applicant contended that Bauer's support does not comprise any integrated latching elements. (Amend. p. 12)

Applicant apparently likewise uses an "*ipsissimis verbis*" test that requires the same terminology in the prior art reference in order to find anticipation or obviousness. See footnote 11 of AKZO N.V. v. *International Trade Commission*, 1 USPQ2d 1241, 1245 (CAFC 1986). It is well settled that an inventor can be his/her own lexicographer. Thus, Bauer is not required to use the same terminology as Applicant uses. Here, as seen in the App., FIG. 1 of Bauer shows

Art Unit: 3656

an element (unnumbered, adjacent to the rod 4) extended from the support 3, 7 for mounting the lever unit to the vehicle by the unnumbered mounting holes (App.), therefore, that element is reasonably interpreted to be the latching element in the same manner as Applicant's latching element 21 shown in Applicant's FIG. 6. See *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification *and drawings*.").

Similarly, Burgstaler's element 3 is extended from the support 1-3 for mounting the lever unit to the vehicle, thus, Burgstaler's element 3 is the latching element in the same manner as Applicant's latching element 21 shown in Applicant's FIG. 6.

Claim 15

Applicant averred:

With respect to claim 15, the Office refers to elements with the reference number 8 -11. However, those elements are side walls made of sheet metal that hold the pedals. In contrast, the claimed metallic mounting inserts in the plate are inserts used to mount the plastic plate to car body. Such metallic mounting inserts are therefore not taught by Burgstaler as the Office contends.

The instant arguments fail from the outset since they are not based on the limitations appeared in claim 15. *In re Self*, 213 USPQ 1, 5 (CCPA 1982). In fact, claim 15 requires: "the support comprises *an electrical switch*, which can be actuated by the parking brake lever." (Emphasis added). Since claim 15 does not mention about the inserts, hence, Applicant's arguments about the inserts cannot be addressed.

In view of the foregoing, Applicant's request to allow the instant application is respectfully declined.

15. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656